



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Q

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

┌

└

EXAMINER

ART UNIT	PAPER NUMBER
----------	--------------

14

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/381,598

Applicant(s)

MIHARA, MASAHIKO

Examiner

Joseph F Murphy

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 16 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 14-22 and 24-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 14-22 and 24-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f)
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application)
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other _____

DETAILED ACTION

Formal Matters

Claim 23 was cancelled, and new claims 24-32 were added in paper No. 13, 6/16/2001. Claims 14-22 and 24-32 are pending and under consideration.

Response to Amendment

The rejections of claim 23 are rendered moot in view of the cancellation of the claim.

The Declaration under 37 CFR 1.132 filed 6/16/2001 is sufficient to overcome the rejection of claims 14-23 as lacking written description under 35 USC § 112, first paragraph for non-compliance with the Budapest Treaty.

Claim Rejections - 35 USC § 112 first paragraph

Pending claims 14-22 stand rejected under 35 USC § 112, first paragraph, for reasons of record set forth in Paper No. 8, 12/28/2000, because the specification, while being enabling for specific anti-IL-6 receptor monoclonal antibodies (PM-1 and MR16-1) as therapeutic agents for diseases involving IL-6, does not reasonably provide enablement for a method of treating multiple sclerosis.

Applicant argues that the Specification demonstrates the in vivo suppression of sensitized T cells by administration of antibodies to IL-6 receptor. However, the claims are directed to methods of treatment of, *inter alia*, multiple sclerosis. Art recognized methods of treatment of

multiple sclerosis are set forth in the Merck Manual (page 1476). The Merck Manual shows that methods of treating multiple sclerosis with the claimed anti-IL-6 receptor monoclonal antibodies are not art recognized, and that absent *in vivo* clinical data it would require undue experimentation to practice this method of treating multiple sclerosis in humans.

The CAFC decision (Genentech Inc. v. Novo Nordisk, 42 USPQ2d 1001, 1997) expressly states that:

"When there is no disclosure of any specific starting material or of any of the conditions under which a process can be carried out, undue experimentation is required; there is a failure to meet the enablement requirement that cannot be rectified by asserting that all the disclosure related to the process is within the skill of the art. It is the specification, not the knowledge of one skilled in the art, that must supply the novel aspects of an invention in order to constitute adequate enablement".

The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. See *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404. The factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue" include, but are not limited to: (1) the breadth of the claims; (2) the nature of the invention; (3) the state of the prior art; (4) the level of one of ordinary skill; (5) the level of predictability in the art; (6) the amount of direction provided by the inventor; (7) the existence of working examples; and (8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure.

Given the breadth of claims 14-22 in light of the predictability of the art as determined by the number of working examples, the level of skill of the artisan, and the guidance provided in

Art Unit: 1646

the instant specification and the prior art of record, it would require undue experimentation for one of skill in the art to practice the claimed invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14-22, 24-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Vink et al.

Vink et al. teaches the administration of anti-IL-6 receptor antibodies (page 998, second column, third paragraph). It is an inherent property of the anti-IL 6 receptor antibodies to suppress sensitized T cells. Newly discovered results of known processes directed to the same purpose are not patentable because such results are inherent. See MPEP 2112-2112.02. See also Bristol-Myers Squibb Company v. Ben Venue Laboratories 58 USPQ2d 1508 (CAFC 2001)1300-1304 (CAFC 4/20/01)

While the prior disclosure was silent as to the suppressing of sensitized T cells of the prior art method of administration of anti-IL-6 receptor antibodies; the instant claims merely recite a newly discovered results --- suppressing sensitized T cells -- of a known method to the same use

The claimed process is not directed to a new use, it is the same use and it consists of the same method as described by Vink et al.


Art Unit: 1646

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph F. Murphy whose telephone number is 703-305-7245. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 703-308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Joseph F. Murphy, Ph. D.
Patent Examiner
Art Unit 1646
August 19, 2001

Prema Mertz
PREMA MERTZ
PRIMARY EXAMINER